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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,511	04/26/2001	Hans-Peter Saluz	F-6954	8214

7590

03/26/2003

Jordan & Hamburg  
122 East 42nd Street  
New York, NY 10168

EXAMINER

BEISNER, WILLIAM H

ART UNIT	PAPER NUMBER
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1744

6

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-6

<b>Office Action Summary</b>	Application No. 09/830,511	Applicant(s) SALUZ ET AL.	
	Examiner William H. Beisner	Art Unit 1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Pre. amendment filed 4/26/01.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

1. The USPTO is participating in a search exchange pilot program with the European Patent Office (EPO). As part of the pilot program, the USPTO has received a copy of the Search Report prepared by the EPO on the counterpart EP application for which priority under 35 U.S.C. 119(a) is claimed. The references cited in the EPO Search Report have been considered by the examiner and have been listed on the PTO-892 form. A copy of these references is not being furnished to applicant with this Office action. It will not be necessary for applicant to submit these references in an information disclosure statement.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 26 April 2001 has been considered and made of record.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

4. The drawings are objected to because Figures 1(a) and 1(b) are not clearly labeled. It is suggested that the drawings be corrected to clearly label views a) and b) of Figure 1 as Figure 1(a) and Figure 1(b), respectively. A proposed drawing correction or corrected drawings are

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required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

5. The disclosure is objected to because of the following informalities:

The specification does not include a clearly identifiable "Brief Description of the Drawings".

Also, the specification does not clearly identify views a) and b) of Figure 1 as "Figure 1(a)" and "Figure 1(b)".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-5, 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it is not clear if a "heat block" is being positively recited as part of the claimed invention. The preamble of the claim merely recites "for heat block thermocycling". The preamble does not indicate that the plate is claimed in combination with a heat block.

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Claim 2 is indefinite because the height of the wells cannot be determined relative to a heat block which has not been positively recited and/or defined with respect to the size of the sample wells in the block which is intended to be used with the plate device.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Tretyakov et al. (Russian Journal of Bioorganic Chemistry).

The reference of Tretyakov et al. discloses an ultrathin-walled multiwell plate device (2) which includes an array of small-volume wells of identical height with the similarly shaped sample wells formed in the top surface of a heat block (1). With respect to the claim limitation that the average thickness of the walls is 20-40 microns, this reference is considered to meet this claim limitation since the device of Tretyakov et al. and the device of the instant invention are formed from a material of the same starting thickness, 60 microns, and the wells are formed using the same method, thermal vacuum-formation method, and result in a final volume of 30microliters which is within the claimed range of 16-85microliters.

With respect to the height of the wells recited in claim 2, Figure 1 of Tretyakov et al. depicts the wells having the same height as the wells of the heat block (1).

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With respect to the shape of the wells of claim 3, Figure 1 of Tretyakov et al. depicts the wells as having a conical shape.

With respect to the decreasing thickness of claim 4, the instant specification recites that the decreasing thickness results from the thermal vacuum-formation method employed which is the same method of formation disclosed by the reference of Tretyakov et al.

With respect to the thermoformation in a negative mold, Figure 1 of Tretyakov et al. depicts the use of a negative mold.

With respect to the rigid frame of claim 7, Figure 1 of Tretyakov et al. depicts the use of a rigid frame (4).

With respect to the claimed well volume of claim 8, the reference of Tretyakov et al. discloses using a well volume of 30 microliters.

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references of Kolehmainen et al.(US 4,349,510); Namba et al.(US 4,743,544); Sado et al.(US 4,971,748); Eigen et al.(US 5,447,679); Dietzel (US 5,802,816); and Dannoux et al.(WO 98/19794) are cited as prior art which pertains to methods of forming multiwelled vessels from a sheet of material.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Beisner whose telephone number is 703-308-4006. The examiner can normally be reached on Tues. to Fri. and alt. Mon. from 6:40am to 4:10pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on 703-308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



William H. Beisner  
Primary Examiner  
Art Unit 1744

WHB

March 20, 2003